

Application No. 10/624,213
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I. REMARKS

INTRODUCTION

The application has been carefully reviewed in light of the Office Action dated March 7, 2006. This communication is believed to be a full and complete response to that Office Action. Claims 1-5, 8, and 10-13 are pending in the present application. By the present Office Action, Claims 1-5, 8, and 10-13 have been rejected.

By the present amendment, Claims 1, 8, 10, and 13 have been amended. No new claims have been added. Claims 2-5, 11, and 12 also remain in the application.

Support for these amendments can be found in the original specification, and thus, no new matter has been added. Applicant reserves the right to pursue all original claims in this or other patent applications. Reconsideration and reexamination of the present application is respectfully requested in light of the foregoing amendments and in view of the following remarks, which establish that the pending claims are directed to allowable subject matter.

SUMMARY OF THE AMENDMENTS

Claims 1 and 8 have been amended to include the feature of the signaling point code being a signaling system 7 signaling point code.

Claims 10, and 13 have been amended to correct matters of form. Claim 10 has been amended to change the indefinite article "a" to the definite article "the". Claim 13 has been amended to correct an antecedent basis problem.

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II. CLAIM REJECTIONS

Under 35 U.S.C. § 112

Claim 10

Claim 10 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 10 has been amended as needed to overcome this rejection. The indefinite article "a" has been changed to the definite article "the" where appropriate.

Under 35 U.S.C. § 102

Claims 1, 2, 4, 5, 8, and 10

Claims 1, 2, 4, 5, 8, and 10 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Application Publication No. 2003/0224811 to Jain et al. ("**Jain**"). Applicant has amended independent Claims 1 and 8 to recite a signaling system 7 signaling point code. The amendment further distinguishes the signaling point code recited in the claims from other addressing schemes that may be described in the cited art.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See MPEP § 2131; *Verdegaal Bros. V. Union Oil Co. of Calif.*, 814 F.2d 628, 631 (Fed. Cir. 1987). **Jain** fails to satisfy this requirement because it does not disclose all of the elements of the rejected claims.

Claim 1

Pending Claim 1 is reproduced below:

Claim 1. A method, comprising the steps of:

migrating a communications device to a Global System for Mobile communications network, the communications device migrated from at least one of the Time Division Multiple Access communications network and a Code Division Multiple Access communications network;

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receiving an origination request from the communications device, the origination request for sending a message from the communications device, the origination request comprising a network address;

associating the network address to a signaling system 7 signaling point code, the signaling point code identifying a message service center in the Global System for Mobile communications network; and

routing the origination request to the message service center operating in the Global System for Mobile communications network,

wherein the originating request is processed by the message service center.

Applicant respectfully submits that *Jain* does not disclose at least the elements highlighted above in bold italics. More specifically, the cited excerpts of *Jain* fail to disclose associating a network address to a signaling system 7 signaling point code. Moreover, *Jain* additionally fails to disclose the signaling point code identifying a message service center in a Global System for Mobile communications network.

Regarding the Office Action's discussion of the element highlighted above in bold italics in the rejection, the Office Action likens the GSM service network 140 of *Jain* to a signaling point code and cites paragraph [0035] as showing the signal point code identifying a message service center in a GSM network. Applicant respectfully submits that the GSM service network 140 of *Jain* is not a signaling system 7 signaling point code. Paragraph [0035] of *Jain* describes providing conversions between GSM and CDMA messaging formats. No mention is made of using a signaling system 7 signaling point code in routing messages between the two networks. *Jain* is therefore insufficient to anticipate the Claim 1 of the present application.

As is known in the art, a signaling system 7 signaling point code comprises a unique code that is assigned to each node in a Signaling System 7 (SS7) network (see e.g., paragraph [0018] of the present application). Element 140 of *Jain*, respectfully, does not comprise a signaling system 7 signaling point code. *Jain* discusses the routing of SMS messages using an SMS service center address (see, e.g., paragraphs [0031] and [0033] of *Jain*). An SMS service center address does not comprise a signaling system 7 signaling point code. The Third Generation Partnership Project is responsible for providing technical specifications for the GSM mobile standard. Technical specifications are available at www.3GPP.org. The following

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information is an excerpt from 3GPP TS 03.40 V7.5.0 *Technical Realization of the Short Message Service (SMS)* (Release 1998). If requested, Applicant will be glad to provide excerpted copies of this specification to the Examiner via facsimile, or a complete copy of the specification via email (TS 03.40 comprises 118 pages total).

5 Service Centre and PLMN interconnection

The present document deals with the SC only with regard to the interchange of messages between SC and MS. Only the requirements put upon the SC by the SMS functionality are specified in the present document.

5.1 Service centre connection

One SC may be connected to several PLMNs, and may be connected to several MSCs (SMS-GMSCs or SMS-IWMSCs) within one and the same PLMN.

The SC is addressed from the mobile by an E.164 number in the numbering plan of the PLMN to which the SC is connected. This E.164 number shall uniquely identify the SC to that PLMN. There may be an intermediate network between the PLMN and the SC; in this case the PLMN must autonomously make a connection to the SC using the SC address in this intermediate network.

No mandatory protocol between the SC and the MSC below the transfer layer is specified by GSM; this is a matter for agreement between SC and PLMN operators. However, annex A provides an example protocol stack which could be used.

In the section highlighted above in bold italics, TS 03.40 explains that the service center (SC) for SMS messaging (an SMSC) is addressed via an E.164 number. As is known in the art, an E.164 number is a number comprising a country code and a subscriber number. A common example of an E.164 number is a telephone number. Applicant submits that the SMSC address described in *Jain* does not comprise a signaling system 7 signaling point code.

Additionally, Applicant would like to respectfully note that on page 8, lines 6-7 of the first Office Action (dated September 29, 2005) the Examiner agreed with Applicant's above assertion in stating that "Jain et al. do not particularly show the step of associating the network address to a signaling point code..." Applicant submits that the Examiner's assessment in the first Office Action of *Jain* lacking this element was correct.

Applicant respectfully submits that the rejection of Claim 1 under this section is improper as described above and requests that the rejection be withdrawn.

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Claim 2

Claim 2 depends from Claim 1 and is therefore allowable for at least the same reasons described above with regard to Claim 1. Applicant respectfully requests that the rejection be withdrawn.

Claim 4

Claim 4 depends from Claim 1 and is therefore allowable for at least the same reasons described above with regard to Claim 1. Applicant respectfully requests that the rejection be withdrawn.

Claim 5

Claim 5 depends from Claim 1 and is therefore allowable for at least the same reasons described above with regard to Claim 1. Applicant respectfully requests that the rejection be withdrawn.

Claim 8

Pending Claim 8 is reproduced below:

Claim 8. A method comprising the steps of:

receiving an origination request at a mobile switching center in at least one of a Time Division Multiple Access (TDMA) communications network and a Code Division Multiple Access (CDMA) communications network, the origination request for sending a message from a communications device, the origination request comprising a network address of a message service center associated with the communication device; and

routing the origination request to the message service center in a Global System for Mobile GSM communications network, comprising routing to a signaling interface between the GSM communications network and the at least one of a TDMA communications network and a CDMA communications network a signaling system 7 Signalling Point Code associated with the signaling interface;

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wherein the origination request is processed by the message service center, thus allowing the message to be sent from the communications device.

Applicant respectfully submits that *Jain* does not disclose at least the elements highlighted above in bold italics. More specifically, the cited excerpts of Jain fail to disclose the use of a signaling system 7 signaling point code associated with a signaling interface. Additional support regarding *Jain's* insufficiency in this area can be found above in the discussion of Claim 1.

Applicant would like to respectfully note that on page 7, lines 13-15 of the first Office Action the Examiner agreed with Applicant's above assertion in stating that "Jain et al. do not particularly show wherein the step of routing to the signaling interface comprises routing to a Signaling Point Code associated with the signaling interface." Applicant submits that the Examiner's assessment in the first Office Action of *Jain* lacking this element was correct.

Claim 10

Claim 10 depends from Claim 8 and is therefore allowable for at least the same reasons described above with regard to Claim 8. Applicant respectfully requests that the rejection be withdrawn.

Additionally, Claim 10 adds the feature of ***associating the network address to the signaling point code, the signaling point code identifying the signaling interface between the Global System for Mobile communications network and at least one of the Time Division Multiple Access communications network and the Code Division Multiple Access communications network.***

The Office Action again cites paragraph [0035] of Jain as disclosing this feature. Applicant respectfully submits that paragraph [0035] makes no mention of the use of a signaling point code or such a code identifying a signaling interface between communication networks.

Claim 12

The Office Action continues to discuss a 35 U.S.C. § 102 rejection of Claim 12. This claim, however, is inconsistent with its rejection under 35 U.S.C. § 103 later in the Office Action where the Office Action states that *Jain* is insufficient to anticipate Claim 12 due to its lack of "disclosing wirelessly changing a network address after migration of a subscription profile."

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Regardless, Claim 12 depends from Claim 8 and is therefore allowable for at least the same reasons described above with regard to Claim 8. Applicant respectfully requests that the rejection be withdrawn. The 35 U.S.C. § 103 rejection is addressed below.

Claim 13

Claims 13 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Application Publication No. 2002/0094811 to Bright ("**Bright**"). We respectfully traverse.

Claim 13 recites the features of conditional message routing based on the "Terminal Type" of a received message. In one case, if the Terminal Type is GSM, a message is routed using a GSM HLR in a GSM network using global title translation for a MSISDN of a terminating communication device. On the other hand, if the Terminal Type is GAIT, message routing uses a TDMA HLR in a TDMA network using global title translation of a mobile subscriber identification number of a terminating communication device.

The portions of **Bright** cited in the Office Action discuss the routing of SMS messages across differing network types using a GPRS interoperability function. The cited sections, however, do not disclose the conditional message routing features of Claim 13. **Bright** discloses converting messages from one network type to another at the interoperability function. **Bright** provides no description of the use of global title translation based for a MSISDN or a mobile subscriber identification number, and thus it follows that no conditional use of global title translation for message routing as claimed in Claim 13 is shown in **Bright**.

At least for the foregoing reasons, Claim 13 is patentable over the disclosure of **Bright**. The Examiner is respectfully requested to withdraw the rejection thereto.

Under 35 U.S.C. § 103(a)

The Office Action rejected Claims 3 and 12 under 35 U.S.C. § 103(a) as being unpatentable over **Jain** in view of U.S. Patent No. 6,625,461 to Bertacchi ("**Bertacchi**").

The Examiner has the burden of establishing a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. 103(a). The CAFC (and the CCPA before it) has repeatedly held that, absent some teaching or suggestion in a primary reference supporting a modification or combination of references, an arbitrary modification of the primary reference or combination of references is improper. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572,

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1577 (Fed. Cir. 1984). *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987). Also, the Federal Circuit has held that it is improper to modify a reference in a way that destroys the intent, purpose, or function of the invention disclosed in the reference. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). For these reasons and others as discussed below, the Examiner has failed to make out a *prima facie* case of obviousness. Each of the Examiner's rejections will now be discussed in view of the above prevailing case law.

To establish *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. See e.g., *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Rouffat*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996). See MPEP § 2142.

Obviousness can only be established by combined or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP § 2143.01; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). It is settled that "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on the applicant's disclosure."

The cited references, when combined, fail to teach all of the limitations of the rejected claims. Furthermore, there is no teaching or suggestion that supports combining the references as proposed.

Claim 3

Claim 3 depends from Claim 1 and is therefore allowable for at least the same reasons described above with regard to Claim 1. Therefore at least the third element of the test for obviousness (the prior art references when combined must teach or suggest all the claim limitations) is not met with regard to Claim 3. No combination of *Jain* and *Bertacchi* disclose the use of a signaling point code as claimed.

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Claim 12

Claim 12 depends from Claim 8 and is therefore allowable for at least the same reasons described above with regard to Claim 8. Therefore at least the third element of the test for obviousness (the prior art references when combined must teach or suggest all the claim limitations) is not met with regard to Claim 12. No combination of *Jain* and *Bertacchi* disclose the use of a signaling point code as claimed.

Applicant respectfully requests that the rejections of Claims 3 and 12 be withdrawn

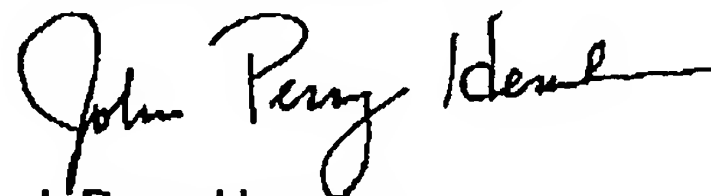
IV. CONCLUSION

For at least the above reasons, Applicant respectfully requests allowance of the claims pending in this case and issuance of a patent containing these claims in due course. Should Examiner Phan believe that a telephone conference would be useful to resolve any concerns and move this application to allowance, Examiner Phan is respectfully requested to contact the undersigned at the telephone number listed below. Otherwise, Applicant respectfully requests timely issuance of a Notice of Allowance for the present application.

V. EXTENSION OF TIME

It is respectfully requested that the period for response to the Office Action dated March 7, 2006 be extended one month, up to July 7, 2006. Form PTO-2038 authorizing payment in the amount of \$120 is enclosed.

Respectfully submitted,



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